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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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12/23/2003

Honjung Lee

118109

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07/23/2007

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EXAMINER

RAE, CHARLESWORTH E

ART UNIT

PAPER NUMBER

1614

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DELIVERY MODE

07/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/743,523	<b>Applicant(s)</b> LEE ET AL.	
	<b>Examiner</b> Charleswort Rae	<b>Art Unit</b> 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) 1-73, 76-78, 84, 87 and 88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 74, 75, 79-83, 85 and 86 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/10/05; 10/06/04</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

Applicant's response with traverse to the Restriction/Election requirements, filed 4/30/07, electing invention V, and coloring agent species as being brown, yellow, or black iron oxide, coated with perfluoroalkyl phosphate, and mica-brown iron oxide as the reflective particle species is acknowledged and made of record. Applicant's statement that at least claims 74, 75, 79, 80, 85, and 86 read on the elected species is acknowledged and made of record.

**Restriction/Election of Species**

Applicant asserts that the subject matter of all claims and species is sufficiently related that a thorough search for the subject matter of any one group of claims or species would encompass a search for the subject matter of the remaining claims or species such that a search of the entire application could be made without serious search burden. Applicant's arguments are not found to be persuasive with respect to the restriction and election requirements for the reasons already made of record in the requirement mailed 3/29/07.

In regards to the elected invention V, the election requirements with respect to coloring agent species of brown, yellow or black iron oxide coated with perfluoroalkyl phosphate, and method species regarding making up dark skin and lightening dark skin are withdrawn as applicant's argument is deemed persuasive.

The restriction/election requirements are made final.

### **Information Disclosure Statement**

It is noted that the foreign patent documents cited in the Information Disclosure Statement, filed 10/6/04, have not been considered. The corresponding English abstracts filed 2/10/05 have been considered, however.

The information disclosure statement filed 10/6/04 fails to fully comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement.

Specifically, citations of US Patent Application serial numbers (10/743,521; and 10/743,455) are improperly cited as these are not considered to be US patent publications.

The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

### **Status of the Claims**

Claims 1-88 are currently pending in this application and are the subject of the Office action.

Claims 1-73, 76-78, 84, and 87-88 are withdrawn for the purpose of examination for being directed to non-elected subject matter.

Claims 74-75, 79-83, and 85-86 are presented for examination.

### **Objection**

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention in view of Applicant's provisional restriction election of invention V (i.e. method). Applicant's cooperation is further requested in correcting this deficiency.

### **Claim rejections – 35 USC 103(a)**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 74-75, 79-83, and 85-86 are rejected under 103(a) for being unpatentable over Okada et al. (US Patent 5,463,009), Simon (US Patent 6,451,294), and Reinehr et al (US Patent 6,818,205).

Okada et al. (US Patent 5,463,009) teach fluorine-modified silicone derived perfluoroalkyl water-repellant cosmetics for use in protecting the skin from water or for preventing makeup up from getting disordered by water or sweat in the form, for example, cosmetics for foundation (col. 1, line 17 col. 2, line 19; see cols. 11-13, Examples 4-8). Okada et al. teach a two-phase liquid **foundation** containing fluorine compound **treated pigments**, titanium oxide, **iron oxide (red, yellow, and black)**, **glycerin, ethanol, and water** (col. 1, Table 2). Like Okada et al., instant claims 74-75, 79-83, and 85-86 encompass foundation type compositions. The glycerin, water, and ethanol, as taught by Okada et al., is reasonably construed to constitute a *physiologically acceptable medium*," as encompassed by said instant claims. The treated pigments as taught by Okada et al. reasonably constitute a "*coloring agent*," while the iron oxide (red, yellow, and black) reasonably constitute "*reflective particles*," as encompassed by said instant claims. Instant claim 74, encompass the limitation "*said composition having a hue angle from 40° to 70°, and a saturation C\* ranging from 20 to 50,*" are reasonably construed to be inherent characteristics of the composition. Okada et al. disclose an evaluation **method for applying the foundation** for

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wearability, retention, and feel on the skin (col. 11, line 52 to col. 12, line 18). Okada et al. teach that the retention of the foundation was evaluated in terms of the degree of removal of the foundation from the skin 8 hours after application. Instant claims 75 and 82, encompass the limitation *"said composition having a reflectance ranging from 10% to 455 in the range of from 600 to 680 nm,"* which is reasonably construed to an inherent characteristic of the instant composition. Okada et al. do not teach specifically teach a method for making up dark skin or lightening dark skin.

Simon (US Patent 6,451,294; **already made of record**) a makeup kit combining a first, goniochromatic pigment and a second pigment, especially a monochromatic pigment, having one of the colors of the first pigment. This kit comprises **two cosmetic makeup compositions** which can be applied to the skin on both the face and other parts of the human body, to the lips and to the exoskeletal appendages such as the nails, eyelashes, eyebrows or hair; the invention also relates to a bilayer makeup method (col 1. lines 14-30). Simon teach said compositions for making up the skin in the form of a solid **foundation** (col. 8, lines 49-57; col. 8, line 64-67). Simon teaches **reflectance** of the composition as a function of wavelength (see Figure 1; see also col. 2, lines 6-11). The invention additionally provides a method of making up the human skin, lips and/or exoskeletal appendages, which comprises **applying to the skin**, lips and/or exoskeletal appendages a **first layer of a first composition** comprising a cosmetically acceptable medium and at least one first colorant and **then applying to part of the said first layer a second layer of a second composition** comprising a cosmetically acceptable medium and at least one second colorant, one of the first and

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second colorants being a goniochromatic colorant able to produce different colors depending on the light incidence and the viewing angle and the other colorant being a monochromatic colorant which produces one of the colors of the goniochromatic colorant (col. 2, lines 22-44). Instant claims 76, 79-80, 83, 85 and 86 encompass two compositions, which are applied separately as taught by Simon (col 2, lines 22-44). Simon does not teach making up dark skin.

Reinehr et al (US Patent 6,818,205) teach a method of using a polymeric carrier material treated with a fluorescent whitening agent for lightening human skin and for protecting human skin against UV radiation (col. 1, line 4 to 7; col. 4, line 65 to col. 14, line 27). Reinehr et al. teach disclose depigmentation compositions are preferably used in people with a naturally **dark skin type** that has elevated melanin concentration to lighten the skin (col. 1, lines 26-30). In view of the teaching of Reinehr et al., the method of lightening or darkening of the skin is reasonably construed to be within the knowledge and skill of an artisan skilled in the art given the level of skin pigmentation/melanin levels of the targeted subject population. Reinehr et al. further teach that the use of a polymeric carrier material treated with a fluorescent whitening agent allows the degree of whiteness of such formulations to be increased, while the UV-absorbing properties provide effective protection against the damaging effect of UV radiation (col. 17, lines 54-66).

Based on the teaching of Reinehr et al. that the polymeric carrier has the advantage of providing UV-absorbing properties, someone of skill in the art would have



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been motivated to combine the teaching of Okado et al., in view of Simon, in view of Reinehr et al. to create the instant inventive concept.

Thus, someone of skill in the art at the time the instant invention was made would have deemed it obvious to create the instant claimed invention with a reasonable expectation of success.

### ***Nonstatutory Obviousness-Type Double-Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

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double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 74-75, 79-83, and 85-86 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16-17 of copending U.S. Patent Application No. 10, 743,521 (Appl. '521). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are either anticipated by, or would have been obvious in view of the referenced claims.

In particular, reference claims 16 and 17 are directed towards a method for lightening a dark skin comprising the application of a cosmetic composition comprising a physiologically acceptable medium; at least one colouring agent. Unlike the claims of the instant application, the composition applied by the reference method does not comprise reflective particles. To the extent that the reference claim recites the term "comprising," someone of ordinary skill in the art would reasonably envisioned the addition of additional active ingredients to the composition.

Thus, claims 74-75, 79-83, and 85-86 are deemed obvious variants of the limitations of copending Appl. '521.

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Claims 74-75, 79-83, and 85-86 are also rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 32-34 of copending U.S. Patent Application No. 11/172,977 (Appl. '977). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are either anticipated by, or would have been obvious in view of the referenced claims.

In particular reference claim 32 is directed towards a process for making up the skin. Unlike the instant claims, the reference claims do not recite a foundation type composition comprising reflective particles. To the extent that the reference claim recites the term "comprising," someone of ordinary skill in the art would reasonably envisioned the addition of additional active ingredients to the composition.

Thus, claims 74-75, 79-83, and 85-86 are deemed obvious variants of the limitations of copending Appl. '977.

This is a provisional obviousness-type double patenting rejection because the conflicting claims of the copending applications have not in fact been patented.

In looking at the continuity data, it is noted that applicant has numerous issued patent and pending applications encompassing the same or similar subject matter of the instant application. Applicant should review all subject matter considered the same or similar, and submit the appropriate Terminal Disclaimer(s). For example, the following US Patents may encompass the same or similar subject matter(s): 6,451,294; 6,663,852; and copending applications, 11/641,785, and 10,743,455.

### Relevant Prior Art

The post-dated art of Henrion et al (US Patent Publication 2002/0012683 A1) and Tomomasa et al. (US Patent 5,948,393) are made of record and relied upon as being pertinent to applicant's invention.

Henrion et al. cosmetic compositions such as foundations containing a suitable vehicle and various coloring agents intended to give the compositions a certain color before and/or after they are applied to the skin (page 1, para. 0002; page 8 to page 9, para. 0170 ). Henrion et al. teach that the compositions contain a cosmetically acceptable medium, i.e. a medium that is compatible with all keratin materials (page 7, paragraphs 0139-0152). Henrion et al. teach that the composition may also contain a particulate phase, which may comprise at least one of pigments, nacres, and fillers, which may be present in the amount ranging from 0% to 155 by weight relative to the total weight of the final composition; these may be chosen from white and colored, mineral and organic, and usual and nanometric sizes (page 8, para. 0164). Metal particles include titanium dioxide, zirconium dioxide, cerium dioxide, zinc oxide, iron oxide, chromium oxide, ferric blue, chromium hydrate, carbon black, ultramarines (aluminosilicate polysulphides), manganese pyrophosphate and silver or aluminum metal powders (page 8, para. 0164). Nacres may be present in the composition in an amount ranging from 0% to 20% by weight, including natural mother-of-pearl, mica coated with titanium oxide, mica coated with iron oxide, mica coated with natural pigment, mica coated with bismuth oxy-chloride, and colored titanium mica (page 8, para. 0165). Henrion et al. teach a method for determining luminance (i.e. values of L,

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a, and b), saturation (i.e. C value), and X-ray diffraction spectrum (page 9, para. 0175 to 10, para. 0208; see also para. 0216-0217).

Tomomasa et al. make-up cosmetic composition such as mascara, eyeliner, foundation, or a spot cover superior in water resistance, perspiration resistance, sebum resistance, oil resistance, and superior staying power (col. 1, lines 9 to col. 4, line 50). The aqueous phase of the composition contain a coloring agent conventionally used for make-up cosmetics e.g. talc, mica, kaolin, calcium carbonate, zinc oxide, titanium dioxide, red iron oxide, yellow iron oxide, black iron oxide, ultramarine, navy blue, carbon black, lower titanium oxide, and others (col. 4, lines 51-65). Tomomasa et al. exemplify an oil foundation (Example 6, col. 7), a O/W emulsion foundation (Example 7, col. 8), and a W/O type emulsion foundation (Example 8, col. 8). Tomomasa et al. disclose contact angle with water (col. 11, lines 20-26).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlesworth Rae whose telephone number is 571-272-6029. The examiner can normally be reached between 9 a.m. to 5:30 p.m. Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached at 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 800-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

19 July 2007  
CER

BRIAN-YONG S. KWON  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'B. Kwon', followed by a long horizontal line extending to the right.